



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,411	12/05/2006	Bernard Dupont	403661/WEINSTEIN	2957
23548 7590 07/29/2009 LEYDIG VOIT & MAYER, LTD 700 THIRTEENTH ST. NW SUITE 300 WASHINGTON, DC 20005-3960			EXAMINER SMITH, JASON C	
			ART UNIT 3617	PAPER NUMBER
			MAIL DATE 07/29/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,411	Applicant(s) DUPONT ET AL.	
	Examiner Jason C. Smith	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 15-25 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 4 and 6-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 03/27/2006 is being considered by the examiner.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the side parts and rolling part of claim 15 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Art Unit: 3617

Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Applicant only discloses side rollers and a central roller. Applicant claims these but also claims a rolling part and side parts. It is best understood that the applicant is talking about the same thing when he is referring to side rollers and side parts as well as a rolling part and the central roller..

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-27 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no description in the specification or drawings in the original disclosure that explains how one of ordinary skill in the art would be able to guide an extremely heavy

Art Unit: 3617

vehicle through mere "pin-point" conduct, and thus undue experimentation would be required by the ordinarily skilled artisan to try and accomplish this feat which would seem difficult if not impossible from an engineering standpoint. The operation of the device is further clouded by the fact that applicant's arguments in response to the last Office action appear to stress this as the defining feature of the applied prior art.

Additionally while applicant's specification and claims call for this "pin-point" contact, the drawings appear to show a significant percent of contact (see figure 2). There is no definition or percentage of contact that defines what applicant intends as "pin-point", and since this is the supposed patentable feature, one of ordinary skill in the art is left to guess how much contact would be considered "pin-point".

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims that the side parts are in "pin point contact", however there are many different sizes of "pins". Applicant's disclosure does not specify what dimensions he/she means by "pin point". "Pin-point" could mean anything from a belying pin (several square inches of contact) to a sewing pin (fractions of square millimeters of contact). In fact there appears to be a conflict in applicant's disclosure and figures in that while applicant's specification and claims call for this "pin-point" contact, the drawings appear to show a significant percent of contact (see figure 2).

Art Unit: 3617

There is no definition or percentage of contact that defines what applicant intends as "pin-point" contact. Consequently, a potential infringer would not know how much contact they could avoid and still not be "pin-point" contact. One reading the claims in light of the specification and disclosure would be left to guess at what cut-off point does the contact go from pin-point to not pin-point, i.e. is the belaying pin pin-point surface, the sewing needle pin-point surface or something in between?

8. Claims 2-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant only discloses side rollers and a central roller. Applicant also discloses a rolling part and side parts. It is best understood that the applicant is talking about the same thing when he is referring to side rollers and side parts as well as a rolling part and the central roller.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-3, 5, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andre et al. (US 7228803) in view of Jensen (6,523,480). Andre discloses a system for guiding a vehicle along a guiding rail, having a rolling surface and at least one side surface that constitutes a guiding surface, the system comprising:

Art Unit: 3617

a guiding roller device cooperating with the rolling surface and the side surface and including a rolling part for rolling contact at a peripheral surface with the rolling surface of the rail (see Fig. 2), and at least one side part coming into contact with the side surface of the rail facing the at least one side part (see Figures), wherein the rolling part and the side part are rotationally connected and the side part is in pin-point contact with the rail and has, at a point of contact with the rail, the same speed as the rolling part on the rolling surface on rail (the speed of the vehicle is also reflected in the speed of the wheel 14 and the speed of the wheel 13 a,b, and their points of contact with the rail of Jensen). Also, for purposes of applying art the examiner will interpret "pin-point" to mean some amount of surface contact less than significantly complete contact between the wheel surface and rail (see rejections under 35 USC 112 above). Andre discloses the guide set forth above, but does not disclose the roller and rolling surface for moving the vehicle. However, Jensen does disclose a roller (14) and surface (15) At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a roller and surface disclosed in Andre in view of the teaching of Jensen. The motivation for doing so would have been to provide a means for the vehicle to move;

[claim 2] wherein the side part of the roller device (Fig. 2) includes at least one rolling support roller and at least one side roller and the side part has a diameter and shape for contacting the rail so that the side roller, at the point of contact with the rail, has the same speed as the rolling part contacting the rolling surface of the rail (see Fig. 2);

[claim 3] for guiding by two parallel guiding rails having exterior side surfaces as guiding surfaces, the guiding system comprising a support roller and a side roller for

Art Unit: 3617

each guiding rail (See Figs. 1-3 of Jensen); **[claims 5, 26, 27]** wherein areas of contact of the side roller have, in radial section, a convex profile, and contact surfaces of the rail are essentially planar (See Fig. 2 of Andre et al.).

Allowable Subject Matter

11. Claims 4 and 6-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. Claims 15-27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason C. Smith whose telephone number is (571) 270-5225. The examiner can normally be reached on M- F, 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. Joseph Morano/
Supervisory Patent Examiner, Art Unit 3617

/Jason C Smith/
Examiner, Art Unit 3617